

*Please add the following claims:*

D14  
85. The method of claim 38, further comprising the step of identifying a specific one of said at least one received unit of television programming on the basis of a unit identification signal embedded in said at least one received unit of television programming.

### III. REMARKS

#### A. Introduction

The Office Action dated October 10, 1997 (Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 5, 7, 8, 10, 11, 13, 16, 17, 18, 20, 22, 23, 31, 32, 34, 35, 36, 37, 38, 39, 40, 42, 49-68, 70-72, 74-76 and 78-84 are amended. Claims 2, 3, 5, 7-11, 13, 16-20, 22-23, 31-40, 42, 44 and 49-84 are pending in the application.

Claims 10, 11, 13, 16, 17, 18, 19, 40, 42, 44, 49-52 and 82 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2, 3, 5, 7-11, 13, 16-19, 40, 42, 44, 49-52, and 56-84 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 5 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haselwood *et al.*, U.S. Pat. No. 4,025,851 in view of the publication "*The Automation of Small Television Stations*," by Young *et al.*

Claims 2, 3, 8, 9, 10, 11, 13, 16, 18, 19, 49, 50-52, 56-71, 75-78 and 80-84 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haselwood in view of Young.

Claim 7 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haselwood in view of Young and the publication "*Microprocessor for CATV Systems*," by Tunman *et al.*

Claims 20, 22 and 23 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haselwood in view of Young and further in view of Kamishima *et al.*

Claims 31, 50, 51, 53 55 and 82 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haselwood in view of Young and further in view of Kamishima *et al.*

Claims 2, 3, 5, 8, 9, 10, 11, 13, 19, 31, 50, 51, 52, 53, 55-71, 75-78 and 80-84 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tunman in view of Young and the publication "*The Digitrol 2 ~ Automatic VTR Programme Control*," by Skilton.

Claim 16 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Tunman in view of Young and Skilton and further in view of Haselwood.

Claims 3-35, 39, 72-74, 81 and 82 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Australian Patent specification by Hetrich in view of Young.

Claims 2, 3, 5, 7-11, 13, 16-20, 22-23, 31-40, 42, 44 and 49-84 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

**B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.**

Applicants respectfully traverse the requirements of the Final Office Action paragraph 4.

Paragraph 4 of the Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to

impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed Cir. 1991).<sup>1</sup> Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

**2. The PTO's Requirement is a Substantive Rule**

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543

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<sup>1</sup>Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

(Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicant's rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

**a) The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).<sup>2</sup> These two well established types of double

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<sup>2</sup>MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing

patenting use an objective standard to determine when they are appropriate<sup>3</sup> and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional*

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a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness-type double patenting analysis".

<sup>3</sup> The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a substantive rule beyond the authority of the PTO and is therefore, invalid.

**b) The New Requirement is Also a Substantive Rule  
Because it Adversely Impacts the Rights and  
Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny

Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants' the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

**c) Conclusion: Substantive Rule**

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

**3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)**

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None

of the options in the requirement is authorize by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of **provisional** double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

**4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO.

Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicant's application is legally untenable.

#### **5. Response to Apparent Conflict of Claims**

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

#### **6. Request for Withdrawal of Requirement**

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by

identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

## **7. Filing of Supplemental Oath**

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

## **C. Information Disclosure Statement**

As a preliminary note, Applicants would like to point out that Supplemental Information Disclosure Statement were filed in the present case on 4/5/96 and 4/7/97. The Office Action only acknowledges receipt of Information Disclosure Statements filed through 6/5/96. Applicants believe the listed 6/5/96 date is a typographical error, and should be the Information Disclosure Statement filed 4/5/96. Confirmation is respectfully requested. In addition, Applicants respectfully request that the Examiner acknowledge receipt of the Information Disclosure Statement filed 4/7/97.

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 2/1/94, 6/6/94, 2/17/95, 5/11/95, 1/4/96, 1/19/96 and (6/5/96? (4/5/96?) and have addressed those specific concerns raised in the office action. It is the Applicants' understanding that the Examiner has raised the following issues:

- (1) the reasons for such a large number of references cited, and
- (2) foreign language references cited without a statement of relevance or translation have not been considered,

**1. Reason for Citation of Large Number of References**

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the

present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

"[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application."

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

## **2. Citations of Foreign Language References**

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, "[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance." The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

**D. Response to Rejections under 35 U.S.C. § 112**

**1. Specification Support of Claims 10, 11, 13, 16, 17, 18, 19, 49-52 and 82**

Paragraph 8 of the Office Action rejects claims 10, 11, 13, 16, 17, 18, 19, 49-52 and 82 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action specified that the language of claims 10, 11, 13, 16, 17, 18, 19, 49-52 and 82 regarding various signals as not being supported by the specification as originally filed.

In response, Applicants respectfully submit that claims 10, 11, 13, 16, 17, 18, 19, 49-52 and 82 have been amended, as recited above, in order to clarify the Examiner's confusion regarding the signals. No new matter has been added.

With respect to claims 40, 42, 44, 49-52 and 82, the Examiner's confusion appears to be primarily over specification support for the steps of selecting programming units and output channels, both in response to a control signal and inputted information. Office Action ¶ 8. In response, Applicants respectfully submit that these concepts are fully supported and disclosed by the originally filed specification.

For example, in one embodiment, i) the "control signal" is a portion of the "complete programming schedule" (disclosed at col. 11, line 22); ii) the "inputted information" includes the portion of the schedule representing "each discrete unit of programming identified" (at col. 11, line 23) and "where the cable head end facility should expect to *receive* (emphasis added) the programming" (at col. 11, lines 26-28); iii) "selecting the [received] units" is "determin[ing] what specific programming and programming unit has been received by each receiver (at col. 11, lines 36-37); and iv) "output channels identified" corresponds to "determin[ing] ... each receiver, 53 through 62, and is passing in line on each individual wire" (at col. 11, lines 34-36). Additionally,

a further example of the operation of the "control signals" and "inputted information" "selecting the [received] units" and having "output channels identified" is disclosed at col. 11, lines 46-57.

Besides the support cited in the paragraph above, the claimed programming schedule is disclosed at col. 11, line 22 and 28-31, as controlling the intermediate station, and includes "when and on which channel or channels the head end facility should *transmit* (emphasis added) each program unit to cable field distribution system 93"

Applicant's believe that the support outlined in the proceeding two paragraphs also addresses questions posed by the Examiner in part C. of the office action; i.e. the selected output channel corresponds to the channels referred to above in the response in the proceeding two paragraphs and is selected in response to the programming schedule.

Applicants respectfully request that the rejection be withdrawn.

## **2. 35 U.S.C. § 112, Second Paragraph**

Claims 2, 3, 5, 7-11, 13, 16-19, 40, 42, 44, 49-52 and 56-84 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have asked to enter the above amended claims 2, 3, 5, 7-11, 13, 16-19, 40, 42, 44, 49-52 and 56-84 in an effort to correct the indefiniteness issues pointed out by the Examiner. *See*, Office Action ¶¶ 6 and 7. No new matter has been added and the claims are believed to distinctly claim Applicants' invention.

## **3. Conclusion**

Applicants respectfully submit that all of the claims of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill

in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994). Applicants' have amended claim 5 to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants' believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

**E. Response to Obviousness Rejection of Claims**

**1. 35 U.S.C. § 103 (a) Claim 5 Rejection over Haselwood *et al.*, U.S. Pat. No. 4,025,851 in view of the publication "*The Automation of Small Television Stations*," by Young *et al.***

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haselwood *et al.*, U.S. Pat. No. 4,025,851 ("Haselwood") in view of the publication "*The Automation of Small Television Stations*," by Young *et al.* ("Young").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Applicants submit the alleged rejection is improper for, at least, failing to disclose every claimed element of Applicants' invention. Therefore, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 5 be withdrawn.

Claim 5 recites, among other things, the following features:

an intermediate television transmission station . . . having a computer for controlling the storage and communication of . . . television programming . . .

receiving signals from said remote source, each of said signals identifying one of said received units or the source of one of said received units;

inputting said signals to the computer;

storing at least one of said received units;

receiving at the computer a programming schedule, said programming schedule designating for at least one of said received units or said at least one stored unit at least one of:

(a) an output channel to be used in communicating the at least one of said received units or said at least one stored unit to said subscriber; and

(b) a time the at least one of said received units or said at least one stored unit is to be communicated to said subscriber; and

communicating at least one of said received units or said at least one stored unit from said station to at least one of said subscriber according to the programming schedule.

At least these features are not disclosed or suggested by the combination of Haselwood and Young. For example, the Office Action admits that the computer (*e.g.*, item 30) disclosed in Haselwood is not the computer recited in claim 5. *See*, Office Action ¶ 10, section III. The computer disclosed in Haselwood, in fact the entire disclosure of Haselwood, is directed to a completely different system from Applicants' claimed invention. Haselwood apparently discloses a "system for automatically monitoring the programs broadcast by commercial television stations." Haselwood, col. 1, lines 8-10. The disclosed "mini-computer 30" functions to store data regarding which programs have been *transmitted* by the affiliate station and the duration of the transmissions. Haselwood, col. 3 line 59 - col. 4, line 2. It is apparent that an intended purpose is to provide a third party *monitor* with a system for monitoring the programming transmitted by affiliate stations. In contrast, Applicants' claimed method provides a system wherein, among other things, a computer at the intermediate station controls the communication of stored programming in conjunction with a schedule. In other words, the computer disclosed by Haselwood stores information regarding the programs *transmitted* by the affiliate whereas, Applicants' computer controls the intermediate station to *output*.

Furthermore, the Office Action attempts to equate the "embedded codes" in Haselwood to Applicants' claimed signals from a remote source. Office Action ¶ 10, section II. However, closer reading of Haselwood demonstrates that this is incorrect. Haselwood discloses that his codes contain information indicating the source of the program. Col. 5, lines 35-36. Haselwood further explains that the source code information indicates the *network* from which it originated (*e.g.*, PBS). Col. 5, lines 48-49.

X While Haselwood may contemplate using *program* identification codes, he ultimately rejects them as being too complicated for his needs. Instead he prefers the "advantage" offered by using only *network* identification codes. *See e.g.*, col. 5, line 63 - col. 6, line 5.

Thus, Haselwood teaches away from Applicants' program identifying codes and, therefore, cannot be properly equated with the claimed invention.

Claim 5 also recites the feature of "inputting said signals to the computer." Haselwood contains no disclosure or suggestion of inputting signals, received from a remote source, into a computer at the station. Haselwood's computer is used simply to store the information regarding which network has been transmitted by the station.

In addition, Haselwood does not disclose or suggest the claimed step of "storing at least one received unit." None of the embodiments disclosed by Haselwood have the even the capability of storing the received units of programming.

Haselwood also does not disclose or suggest the step of "receiving, at the computer, a programming schedule." In fact, quite the opposite, Haselwood's computer records information regarding what has already *been* transmitted. This inherent difference between Haselwood and Applicants' invention is evident by an examination of Haselwood Figure 3. As can be seen, program selector 46, which selectively connects a program source (*e.g.*, network feed 16 or local source 44), is connected "upstream" of decoder 28 and mini-computer 30. Thus, a program is first selected for transmission and communicated to the transmitter, then the coding is read into mini-computer 30, finally the program is transmitted. As recited in claim 5, it is evident that Applicants' method operates in a different fashion. In particular, a unit of programming and a signal identifying each unit are first received, then a programming schedule and the computer are used to select at least one of an output channel or output time to broadcast a program. Thus, unlike Haselwood, Applicants' computer is used to control the broadcast station, not to merely record what has been transmitted.

This operational difference is also apparent from examination of Haselwood, Fig. 2. In this embodiment the mini-computer is not even located at the transmission station. Instead, the computer is located at a remote monitor station. Thus, Haselwood's invention can be accomplished with the computer downstream of the

transmitter. Clearly, the computer disclosed by Haselwood is not used to control the communication of programming.

In a subsequent section, the Office Action alleges that “the affiliate station of Haselwood *et al.* must have comprised control circuitry which would have enabled the station’s operator to have controlled the program source (44) and the program selector (46) to perform the tasks required of them . . . it is maintained that the affiliate station . . . inherently comprised control circuitry . . .” Office Action ¶ 10, section IV A (emphasis added). Applicants’ respectfully disagree. Haselwood’s only mention of the operation of the program selector 46 states that the selector 46 “is used to selectively connect the network feed line 16 or the program source 44 to the transmitter 42 so that either a network or a local program may be broadcast.” Col. 4, lines 29-32. No disclosure or suggestion is given that *any* circuitry is used to accomplish the selector task. In fact, Young, a reference relied upon in the Office Action, describes how some affiliate broadcast stations commonly accomplish the selector task. As described in Young, it was common in the 1970’s to accomplish program selection by having “three persons continuously ‘watching television’ their sole activity being to make sure that the commercials and station breaks go out correctly.” Young, p. 806, col. 1. Thus, it may be just as “inherent” that Haselwood’s contemplated program selection was accomplished manually and without any circuitry at all.

Furthermore, the above noted Haselwood configurations shown in Figs. 2 and 3 demonstrate that Haselwood does not control the transmitter station. Located where it is, beyond the selection for transmission point, the computer of Haselwood is not able to control the transmitter station to communicate its identified signal to *any* destination.

To supply the admitted deficiencies of Haselwood, the Office Action relies on Young “for its discussion of conventional control circuitry which was used to control conventional affiliate stations.” Office Action ¶ 10, section IV B. Be that as it may, Young still does not suggest or disclose Applicants’ claimed invention. For example,

Young does not suggest or disclose the receiving of signals from a remote source, and subsequently inputting said signals into the computer. Any signals input into Young's computer is done manually or with punch cards.

Young also does not disclose the storing of programming units received from said remote source. To the extent that Young discloses the storing of any programming, it is always local programming.

Furthermore, the system disclosed in Young is markedly different from Applicants' claimed invention. Young appears to disclose an automation system wherein engineers manually load various sources of programming (*i.e.*, VTR players, and audio cartridge machines) then, a card machine reader is programmed to control the playing and switching of the various loaded devices. Therefore, engineering personnel are required in the process to load the machines and to program the switching. In contrast, broadcasting from Applicants' intermediate transmission station can be accomplished entirely on an automated basis. Thus, Haselwood and Young alone and in combination fail to disclose or suggest each claimed feature of Applicants' invention.

In addition to failing to disclose each of Applicants' claimed features, one of ordinary skill in the art would not be motivated to combine the disclosures of Haselwood and Young in the manner suggested. Haselwood is apparently directed to a system "for automatically monitoring the programs *broadcast* by commercial television stations." Col. 1, lines 8-10 (emphasis added). Young is apparently directed to a system for automating the broadcasting of programming. The system of Young uses a scripted list (*i.e.*, computer punch cards) to broadcast programming. Thus, after preparing a list of programming "events" to be broadcast, it is unlikely that one of ordinary skill would then be motivated to implement a system to monitor which programs are broadcast. They know in advance what programs are going to be broadcast because, they prepared the "to be broadcast" list in the first place.

Likewise, Haselwood contains no motivation or suggestion that the manner in which the programs are broadcast be automated, or even that it is desirable to do so. Haselwood is only concerned with monitoring the programs that have been broadcast, thus, there is no motivation to automate how they are broadcast. In fact, to do so would require additional equipment and would not serve to further the goal of Haselwood's device. For example, an additional computer would be required to automate the transmission station and this additional computer would not contribute to the function of the original computer in recording the transmitted programs. Also, an additional decoder would be required at the transmission station because, there is no assurance that all the incoming network programming will be transmitted. Indeed, Haselwood's object is to determine which network programming *is* transmitted. Therefore, one of ordinary skill would not be motivated to incorporate unnecessary and costly equipment into the device of Haselwood.

For at least the foregoing reasons, Applicants' respectfully submit that the alleged rejection of claim 5 is improper. Applicants' respectfully request that the rejection be withdrawn.

**2. 35 U.S.C. § 103(a) Rejection Of Claims 2, 3, 8, 9, 10, 11, 13, 16, 18, 19, 49, 50-52, 56-71, 75-78 and 80-84 Over Haselwood in view of Young**

Claims 2, 3, 8, 9, 10, 11, 13, 16, 18, 19, 49, 50-52, 56-71, 75-78 and 80-84 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Haselwood in view of Young. As noted above, the combination of Haselwood and Young is improper for failing to disclosed Applicants' claimed invention and failing to provide proper motivation for their combination. While all of the above arguments also apply here, a few additional comments are provided.

First of all, claims 8, 9, 49-52, 51 and 82 all depend from claim 5. As noted above, Haselwood in view of Young fails to teach each element of claim 5. Therefore, claims 8,

9, 49-52, 51 and 82 , which include the features of claim 5, are not suggested or disclosed by Haselwood and Young either.

Claims 10, 56, 62, 63, 65, 68, 75, 78, 83 and 84 all contain features not disclosed by Haselwood, Young or their combination. For example, claim 10 recites,  
... a computer for controlling the communication of said television programming ... receiving a plurality of signals from a remote programming source, each signal designating one unit of said loaded units or said received units ... identifying in response to each of said signals said one unit designated ... communicating said one unit ...

Claim 56 recites,  
... a computer for controlling the communication of said television programming ... receiving at the computer a programming schedule that designates for said loaded at least one unit or said received at least one unit ... an output channel ... a time for communicating ... selecting one of said loaded or said received at least one units ... based on said programming schedule ...

Claim 62 recites,  
... said station having a computer for controlling the communication of programming ... storing at least on of said received units ... receiving a programming schedule that designates ... an output channel ... a time for communicating ... selecting one of said received units or said stored at least one unit ... communicating said selected unit ... according to said programming schedule ...

Claim 63 recites,  
... said station having a computer for controlling the communication of said television programming ... storing a plurality of units ... receiving at the computer a programming schedule that designates ... a time for communication ... an output channel ... selecting one unit ... based on said programming schedule ...

Claim 65 recites,  
... the station having a computer for controlling the communication of units of said television programming ... storing a plurality of said units .  
... receiving a plurality of signals from a remote programming source ...  
receiving at the computer a programming schedule that designates ... an output channel ... a time for communicating ... selecting one of said stored units in response to one of said signals ...

Claim 68 recites,  
... storing a plurality of said units of television programming ...  
receiving a plurality of signals from said remote source ... receiving at a

computer a programming schedule that designates . . . an out put channel . . . a time for communicating . . . selecting one unit . . . based upon at least one of said received signals . . .

Claim 75 recites,

. . . the station having a computer for controlling the communication of programming . . . storing a unit of said television programming and a unit identification signal . . . receiving at the computer a program schedule that designates for said stored unit . . . an output channel . . . a time for communicating . . . outputting said stored unit and said identification signal . . . at the time or onto the channel designated by said programming schedule . . .

Claim 78 recites,

. . . the station having a computer for controlling the communication of said television programming . . . receiving at a receiver a signal from the remote programming source . . . storing a plurality of units of said programming . . . scheduling, for communication, one of said units . . . selecting at least one unit of said received unit or said stored unit based on the received signal . . .

Claim 83 recites,

. . . a computer electrically connected to said receiver . . . said computer having access to a programming schedule, the programming schedule designating for at least one unit of said received units . . . a time to communicate . . . one of said one or more output channels to be used for communicating . . . said computer programmed to perform . . . selecting each said unit of said received units or said stored units . . .

Claim 84 recites,

. . . a computer electrically connected to said switch and said storage devices, said computer having access to a programming schedule, the programming schedule designating for at least one unit of said stored units . . . a time to communicate . . . an output channel for communicating . . . a signal detector . . . for detecting the unit identification signals . . . said computer programmed to perform . . . identifying one of said storage devices . . . communicating the outputted unit to a subscriber according to the programming schedule . . .

As discussed previously, in connection with the rejection of claim 5, at least these claim features are not disclosed or suggested by Haselwood, Young or their combination. Therefore, Applicants respectfully request the rejections be withdrawn.

In addition to the already mentioned deficiencies of Haselwood and Young, one more is pointed out here. Claim 83 recites designating "one of said *one or more output*

*channels* to be used for communicating.” The affiliate stations described by Young and Haselwood are just that, network affiliates transmitting *all* programs over the *same* channel. In other words, following the disclosures of Haselwood and Young, the local network affiliate (*e.g.*, WJLA - the Washington, D.C. affiliate for ABC) will select either the network program (*e.g.*, ABC’s *Nightly News*) or a local program (*e.g.*, WJLA’s 11:00 o’clock news) and then, the selected program will be output over one channel (*e.g.*, channel 7). Thus, there is never a need for Haselwood or Young to designate an output channel from a plurality of channels because, there is only one output channel available.

Claims 2, 3, 11, 13, 18, 19, 49-52, 57-61, 64, 66-67, 69-71, 76-77 and 81-82 all depend from variously from claims 5, 10, 56, 62, 63, 65, 68, 75 or 78. As noted above, Haselwood in view of Young fails to teach each element of claim 5. Therefore, claims 2, 3, 11, 13, 18, 19, 49-52, 57-61, 64, 66-67, 69-71, 76-77 and 81-82, which include the features of claims 5, 10, 56, 62, 63, 65, 68, 75 or 78, are not suggested or disclosed by Haselwood and Young either.

**3. 35 U.S.C. § 103(a) Rejection Of Claim 7 Over Haselwood in view of Young and The Publication “*Microprocessor for CATV Systems*,” By Tunman *et al.***

Claim 7 has been rejected as being allegedly unpatentable over Haselwood in view of Young and further in view of the publication “*Microprocessor for CATV Systems*,” by Tunman *et al.* (“Tunman”). Tunman is relied upon to show the “obviousness of having simply extended the automation structure which was used for single channel affiliate broadcast stations . . . to cable broadcast applications.” Office Action ¶ 12. To the extent that Tunman does disclose this (and Applicants do not concede that it does), it does not repair the shortcomings of Haselwood and Young as noted above. Therefore, the features of claim 5, which are present in claim 7, are not suggested or disclose by the combination of Haselwood, Young and Tunman. Applicants respectfully request that the rejection be withdrawn.

**4. 35 U.S.C. § 103(a) Rejection Of Claims 20, 22 and 23 Over  
Haselwood in view of Young and Further In View Of  
Kamishima *et al.***

Claims 20, 22 and 23 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Haselwood in view of Young and further in view of Kamishima *et al.*, ("Kamishima"). Applicants respectfully submit that this rejection is improper for at least the reasons give above in the remarks regarding claim 5. Claim 20 recites, among other things,

. . . each of said received signals identifying one of the received units or identifying the source of the received units . . . said storage device storing signals identifying the stored units . . . a computer electrically connected to said receiver . . . said computer having access to a programming schedule . . . designating . . . a time to communicate . . . an output channel . . . said computer selecting each of said at least one unit of said received or said stored units designated by said programming schedule based upon said received signals and said stored signals . . .

As noted in the remarks pertaining to claim 5, at least these features are not disclosed or suggested by Haselwood and Young. Kamishima is relied upon to disclose "means for monitoring the operation of the program selector." Office Action ¶ 13. As such, Kamishima does not repair the deficiencies of Haselwood and Young. Therefore, Applicants respectfully submit that this rejection is improper and request that it be withdrawn.

**5. 35 U.S.C. § 103(a) Rejection Of Claims 31, 50, 51, 53 55 and  
82 Over Haselwood in view of Young and Further In View  
Of Kamishima *et al.***

Claims 31, 50, 51, 53 55 and 82 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Haselwood in view of Young and further in view of Kamishima *et al.*, ("Kamishima"). Applicants respectfully submit that this rejection is improper for at least the reasons give above in the remarks regarding claim 5. Claim 31 recites, among other things,

. . . said station having a computer for controlling the communication of said television programming . . . receiving a programming schedule designating for said received at least on unit or said stored units . . . an

out put channel . . . an approximate time . . . detecting said signal . . . passing said detected signal to the computer . . . identifying that said detected signal is a predetermined signal . . . communicating on unit . . . in response to said step of identifying and according to said programming schedule.

As noted in the remarks pertaining to claim 5, at least these features are not disclosed or suggested by Haselwood and Young. Kamishima is relied upon to disclose "means for monitoring the operation of the program selector." Office Action ¶ 13. As such, Kamishima does not repair the deficiencies of Haselwood and Young. Therefore, Applicants respectfully submit that this rejection is improper and request that it be withdrawn.

Claims 50, 51, 53, 55 and 82 depend from claim 31. As noted above, Haselwood in view of Young and Kamishima fails to teach each element of claim 31. Therefore, claims 50, 51, 53, 55 and 82, which include the features of claim 31 are not suggested or disclosed by Haselwood and Young either.

**6. 35 U.S.C. § 103(a) Rejection Of Claims 2, 3, 5, 8, 9, 10, 11, 13, 19, 31, 50, 51, 52, 53, 55-71, 75-78 and 80-84 Over Tunman in view of Young and the publication "*The Digitrol 2 ~ Automatic VTR Programme Control*," by Skilton**

Claims 2, 3, 5, 8, 9, 10, 11, 13, 19, 31, 50, 51, 52, 53, 55-71, 75-78 and 80-84 are rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Tunman in view of Young and the publication "*The Digitrol 2 ~ Automatic VTR Programme Control*," by Skilton ("Skilton"). See, Office Action ¶ 15 and 16. The deficiencies of Tunman and Young have been noted above. Skilton, is apparently relied upon to disclose that "local programming sources of such systems conventionally comprised VTRs which were loaded tapes containing prerecorded local programming such as advertisements." Office Action ¶ 15, section III. As such, Skilton does not repair the deficiencies of Tunman and Young. Therefore, Applicants respectfully submit that the rejection is improper for at least failing to disclose at least the claimed features recited above.

Furthermore, Applicants respectfully submit that the rejection is improper for failing to provide a proper motivation for combining Tunman, Young and Skilton. The Office Action does not provide any motivation beyond baldly stating:

[in] (sic) evidenced by the showing of Skilton and Young *et al.*, it is maintained that it would at least have been obvious to one skilled in the art to have implemented a portion of the local programming source in the system disclosed by Tunman *et al.*, with conventional VTRs loaded with cassette tapes containing prerecorded local programming.

Office Action ¶ 15, section IV. No other motivation is provided. Applicants respectfully point out that the above reasoning is akin to arguing "it would have been obvious because, it would have been obvious." This is simply not proper. As stated above, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j). These requirements have not been fulfilled, therefore, Applicants respectfully request the rejection be withdrawn.

**7. 35 U.S.C. § 103(a) Rejection Of Claim 16 Over Tunman in view of Young and Skilton and Further In View Of Haselwood**

Claim 16 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tunman in view of Young and Skilton and further in view of Haselwood. As noted above, the combination of Tunman, Young, Skilton and Haselwood does not disclose or suggest each of the claimed feature of Applicants' invention. Furthermore, the Office Action provides no motivation for combining this string of references other than "it

would have been obvious.” *See*, Office Action ¶ 17. Thus, Applicants submit that the rejection is improper and request that it be withdrawn.

**8. 35 U.S.C. § 103(a) Rejection Of Claims 3-35, 39, 72-74, 81 and 82 Over Australian Patent specification by Hetrich in view of Young**

Claims 3-35, 39, 72-74, 81 and 82 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Australian Patent specification by Hetrich (“Hetrich”) in view of Young. *See*, Office Action ¶ 18 and 19. Applicants respectfully submit that this rejection is improper for at least the reasons stated above. In addition, Hetrich and Young do not disclose the features of claims 3-35, 39, 72-74, 81 and 82 listed above. Furthermore, the Office Action again fails to provide any motivation for combining the references beyond merely stating that “it would have been obvious.” Applicants also note that the asserted motivation that FCC rules require a log (Office Action ¶ 18, section IV) is also not proper. While the existence of FCC rules may make it obvious to comply with the rules, they do not make it obvious to combine the disclosures of Hetrich and Young. Therefore, Applicants respectfully submit that the rejection is improper and should be withdrawn.

Additionally, as the Office Action notes, Hetrich is directed to *radio* broadcasting. Office Action ¶ 18, section I. While Hetrich may contain one afterthought line “or television station,” the *entire* disclosure including the claims are directed to a radio broadcast system. As such one of ordinary skill would not have looked to the non-analogous field of radio transmission to solve the problems of a television broadcaster. Thus, Applicants respectfully submit that Hetrich is not applicable as a reference, and the rejection should be withdrawn.

**F. Allowable Subject Matter**


Applicants gratefully acknowledge the indication of allowable subject matter in claims 34-38 and 54. Office Action ¶ 21.

#### IV. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Date: April 10, 1998  
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## APPENDIX A

## APPENDIX A

The following foreign reference has been cited by Applicants in the Information disclosure Statements previously filed. Applicants have further included the following relevancy statement as well as an English abstract (in the case of foreign patents), thus meeting the requirements as set forth in 37 CFR 1.98 and MPEP § 609.

**23 38 330      February 13, 1975      Germany**

This reference discloses television receivers that transmit control signals to a decoder/processor combination.

**61-050470      March 12, 1986      Japan**

This reference discloses a program reserving device of a television receiver encompassing a control circuit displaying content of reservation and a means for supplying plural background pictures to a display patten of reserved content and changing the background picture to the 1st and 2nd states depending on the state of the reserved input.

**60-61935      April 9, 1985      Japan**

This reference discloses a video recording procedure by which programs selected for recording card are stored to a memory which actuates a built-in recording timer.

**2 058 681      June 15, 1972      Germany**

This reference discloses a television mode arrangement for transmitting, receiving, and presenting coded information.

**For the Information Disclosure Statement filed 4-7-97:**

**0 020 242      December 10, 1980      European**

This reference discloses a teletext character alignment process.

**0 046 108      February 17, 1982      European**

This reference discloses a integrated circuit interface between a television receiver and recorder.

**0 049 184      April 7, 1982      European**

This reference discloses a pocket teaching aid using a television receiver with a teletext system.

**0 055 167      June 30, 1982      European**

This reference discloses a teletext CRT display for messages from a composite memory.

**0 077 712      April 27, 1983      European**

This reference discloses a multi-channel digital packet television broadcasting system.

**0 078 185      May 4, 1983      European**

This reference discloses a digital packet broadcasting system using television transmissions.

**2 496 376      June 18, 1982      France**

This reference discloses a teletext display of data on the television screen.

**2 516 733      May 5, 1983                      France**

This reference discloses an error controller for a teletext television decoder.

**2 823 175      November 29, 1989                      Germany**

This reference discloses a teletext information display for television transmission.

**24 53 441      May 13, 1976                                  Germany**

This reference discloses a wideband signal transmission with digital to image signal conversion.

**DE 30339949 May 6, 1982                                  Germany**

This reference discloses a method for the generation of teletext display having a color character contrast.

**DE 3112249    October 7, 1982                                  Germany**

This reference discloses a processing signals from either a colored television receiver or from a video text decoder.

**DE 3020787    December 17, 1981                                  Germany**

This reference discloses a television transmission system that sends extra data during a blanking period.

**WO 80/00292    February 21, 1980 Japan**

This reference discloses a decoder for a television receiver that has a color component that splits signals and recombines the signals into a composite drive current signal.

**WO 83/00789 March 3, 1983      Japan**

This reference discloses an image display unit which displays received image signals via a memory, wherein the image signals include teletext displays of weather reports or television programs.

**Graf, P.H., "Antiope-Uebertragung fuer Breitbandige Videotex-Verteildienste," 1981.**

This reference shows an Antiope demodulator/detector.

**Heller, Arthur, "VPS - Ein Neues System Zuragsgesteuerten Programmanfzeichnung, Rundfunk technisde Mitteilungen, pp. 162-169.**

This reference discloses a decoding system for use with a VCR.

**Marti, B et al., Discrete, service de television cryptee, Revue de radiodiffusion - television (1975), pp. 24-30.**

This reference discloses an analog decryption system.

**Strauch, D., "(Las Media De Telecommunication Devant la Rapture. Les Nonvellas Methodes Presentees a L'Eposition International 1979 de Radio (Et Television)) 1979.**

This reference is a discussion of videotext, teletext, ceefax, oracle, and antiope.